

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	Philyaw et al.	
Application Serial No.:	09/382,426	Confirmation No.: 5220
Filing Date:	August 24, 1999	
Group:	3625	
Examiner:	Mark A. Fadok	
Title:	METHOD AND APPARATUS FOR COMPLETING, SECURING AND CONDUCTING AN E-COMMERCE TRANSACTION	

BRIEF ON APPEAL

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APPELLANTS' MAIN BRIEF ON APPEAL

This Brief is submitted in accordance with 37 C.F.R. § 41.67 concerning the Notice of Appeal filed October 05, 2007 in response to the Final Office Action dated April 05, 2007, wherein the Examiner finally rejected claims 1-29 that comprise all of the pending claims in this application.

I. Real Party Interest.

The party in interest is L.V. Partners, L.P., a Texas limited partnership, whose general partner is LV GP, L.L.C., and whose principal office and place of business is at 2626 Cole Avenue, Dallas, Texas 75204.

II. Related Appeals and Interferences.

Appellants have the following related application pending appeals:

- U.S. Patent Application Serial No. 09/614,937, Appeal No. 2007-1745, DECIDED ON December 7, 2007 (attached as Exhibit K) entitled

“LAUNCHING A WEB SITE USING A PASSIVE TRANSPONDER” (Atty. Dkt. No. PHLY-25,356), filed on July 11, 2000;

- U.S. Patent Application Serial No. 09/382,374 entitled “METHOD AND APPARATUS FOR ALLOWING A BROADCAST TO REMOTELY CONTROL A COMPUTER” (Atty. Dkt. No. PHLY-24,736), filed August 24, 1999;
- U.S. Patent Application Serial No. 09/642,891 entitled “RETRIEVING PERSONAL ACCOUNT INFORMATION FROM A WEB SITE BY READING A CREDIT CARD” (Atty. Dkt. No. PHLY-25,338), filed on August 21, 2000.

Appellants have filed Notices of Appeal in the following related application:

- U.S. Patent Application Serial No. 09/568,205 entitled “METHOD AND APPARATUS FOR A UNIQUE TRANSACTION CODE TO UPDATE A MAGAZINE SUBSCRIPTION OVER THE INTERNET” (Atty. Dkt. No. PHLY-24,914), filed on August 24, 1999.

The above-identified patent application has no related interferences.

III. Status of the Claims.

Claims 22-27 from the application are pending, stand firmly rejected, and are on appeal here. A complete and current listing of Claims 1-29 are attached here in the **CLAIMS APPENDIX**.

IV. Status of Amendments.

Appellants filed an Amendment After Final on May 21, 2007 in response to the Final Office Action, mailed April 05, 2007, which was not indicated as entered, but which is attached hereto as Exhibit J; however, no amendments to the claims were presented. Appellants filed a Pre-Appeal Brief Request for Review on October 05, 2007, with its Reason in Support of Pre-Appeal Brief Request for Review which rejected Claims 1-29. An amendment filed January 17, 2007 was the last Response amending the claims and was the last Response entered.

V. Summary of the Claimed Subject Matter.

The present invention, as set forth currently in independent Claim 1, relates to a method for processing profile information of a user for conducting an on-line transaction between the user and a vendor. The method comprises the steps of entering profile information of a user into a profile form at a user location disposed on a network¹ prior to conduction of an on-line transaction between the user and the vendor,² wherein the vendor is disposed at a vendor location on the network.³ The method includes issuing, to the user, a unique code representing the stored profile information of the user.⁴ The unique information is issued in response to the user transmitting the profile form from the user location to a second location on the network.⁵ The unique information is stored at the second location⁶ disposed on the network.⁷ An on-line transaction is initiated by selecting a product of the vendor at a user location.⁸ After selecting the product, the user provides the unique code to the vendor location for purchase of the product.⁹ The user provides the unique code to the vendor location during the on-line transaction.¹⁰ The on-line transaction requires the user to view a vendor payment form at the user location representing information about the transaction.¹¹ The vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user.¹² The stored profile information must be viewed by the user prior to completion of the on-line transaction.¹³ The method further comprises providing the stored profile information, from the second location, to the vendor location in response to the vendor location receiving and processing the unique code.¹⁴ Additionally, the method comprises automatically inserting, by the vendor, at least a portion of the stored profile information of the user into the vendor payment

¹ See specification at page 50, lines 18-20; page 51, lines 4-15; and page 52, lines 19-25.

² See specification at page 50, lines 21-22; page 53, lines 6-11; and page 60, lines 1-5 (on-line transaction).

³ See specification at reference number 2700 on Figure 27; and page 53, lines 6-11.

⁴ See specification at page 51, lines 15-17; page 51, lines 25-26; page 52, lines 1-18; and page 53, lines 1-3.

⁵ See specification at page 51, lines 15-17; page 52, lines 25-27; and page 53, lines 1-3.

⁶ See specification at page 53, lines 15-18; and page 55, lines 7-13.

⁷ See specification at Figure 27; page 53, lines 18-21; and page 55, line 7.

⁸ See specification at page 53, lines 9-13; page 60, lines 1-5.

⁹ See specification at page 50, lines 22-25; page 51, lines 17-24; page 53, lines 11-26; page 54, lines 1-14; page 55, lines 24-27; and page 60, lines 5-13.

¹⁰ See specification at page 51, lines 17-24; page 53, lines 11-26; page 54, lines 1-14; page 55, lines 24-27; and page 60, lines 5-13.

¹¹ See specification at page 53, lines 21-25; and page 60, lines 23-26.

¹² See specification at page 53, lines 21-25.

¹³ See specification at page 53, lines 21-25.

¹⁴ See specification at page 54, lines 15-21; and page 56, lines 1-9.

form for respective associated fields therein¹⁵ for presentation to the user at the user location after the insertion.¹⁶ Therefore, when the user receives the form for viewing, the insertion has already occurred¹⁷ and the user has not viewed the form other than with already populated certain fields prior to reception.¹⁸

The present invention, as set forth currently in dependent Claim 2, relates to the method of Claim 1, wherein the user fills in the profile only one time.¹⁹

The present invention, as set forth currently in dependent Claim 3, relates to the method of Claim 1, wherein the profile form is transmitted to the second location over a public switched telephone network.²⁰

The present invention, as set forth currently in dependent Claim 4, relates to the method of Claim 1, wherein the vendor location receives the profile information from the second location in response to the vendor location transmitting the unique code to the second location.²¹

The present invention, as set forth currently in dependent Claim 5, relates to the method of Claim 1, wherein the unique code is unique and has a unique ID number associated therewith.²²

The present invention, as set forth currently in dependent Claim 6, relates to the method of Claim 1, wherein the unique code has a unique ID number associated therewith and the user provides the unique ID number to the vendor location for the payment purposes.²³

The present invention, as set forth currently in dependent Claim 7, relates to the method of Claim 1, wherein the step of automatically inserting causes all of the profile information to be entered into the vendor payment form as encoded information.²⁴

¹⁵ See specification at page 53, lines 21-25; and page 56, lines 8-12.

¹⁶ See specification at page 53, lines 21-25; and page 56, lines 8-12.

¹⁷ See specification at page 53, lines 21-25.

¹⁸ See specification at page 53, lines 21-25.

¹⁹ See specification at page 50, lines 18-20; and pages 50, lines 25-26.

²⁰ See specification at page 53, lines 7-11; and page 55, lines 11-13.

²¹ See specification at page 54, lines 11-21; and page 56, lines 1-9.

²² See specification at reference number 2502 on Figure 25; and page 51, lines 17-19.

²³ See specification at reference number 2502 on Figure 25; page 51, lines 17-19; and page 53, lines 15-21.

The present invention, as set forth currently in dependent Claim 8, relates to the method of Claim 1, wherein the step of automatically inserting causes only a portion of the profile information to be entered into the vendor payment form as encoded information.²⁵

The present invention, as set forth currently in dependent Claim 9, relates to the method of Claim 8, wherein the portion of the profile information is credit information.²⁶

The present invention, as set forth currently in dependent Claim 10, relates to the method of Claim 1, wherein the wherein the profile information comprises name, address, ship-to address, and credit information.²⁷

The present invention, as set forth currently in dependent Claim 11, relates to the method of Claim 5, wherein the second location is a central registration server having a database of the profile information associated with respective unique codes and unique ID numbers.²⁸

The present invention, as set forth currently in dependent Claim 12, relates to the method Claim 11, wherein the second location is a credit card company server.²⁹

The present invention, as set forth currently in dependent Claim 13, relates to the method of Claim 1, wherein the unique code is placed on a credit card.³⁰

The present invention, as set forth currently in independent Claim 14, relates to a system for processing profile information of a user for conducting an on-line transaction between the user and a vendor. The system comprises profile information of a user entered into a profile form at a user location disposed on a network.³¹ The profile information is entered into the profile form prior to the conduction of an on-line transaction between the user and the vendor.³²

²⁴ See specification at page 53, lines 21-25; and page 56, lines 1-9.

²⁵ See specification at page 54, lines 21-25.

²⁶ See specification at page 51; lines 9-13.

²⁷ See specification at page 51, lines 6-9; and page 57, lines 21-26.

²⁸ See specification at page 54, lines 15-21.

²⁹ See specification at page 52, lines 25-27; and page 61, lines 1-27.

³⁰ See specification at page 51, lines 25-26; page 52, lines 1-18; and page 53, lines 1-3.

³¹ See specification at page 50, lines 18-20; page 51, lines 4-15; and page 52, lines 19-25.

³² See specification at page 50, lines 21-22; page 53, lines 6-11; and page 60, lines 1-5 (on-line transaction).

wherein the vendor is disposed at a vendor location on the network.³³ The system includes a unique code representing stored profile information of the user.³⁴ The unique code is issued to the user in response to the user transmitting the profile form from the user location to a second location on the network for storage thereat,³⁵ wherein the second location is disposed on the network.³⁶ The unique code is provided to the vendor location, by the user, for purchase of a product of the vendor after the user has viewed and made a selection of the product³⁷ during the on-line transaction.³⁸ The on-line transaction requires the user to view a vendor payment form at the user location representing information about the transaction.³⁹ The vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user and which must be viewed by the user prior to completion of the on-line transaction.⁴⁰ The profile information is provided from the second location to the vendor location in response to the vendor location processing the unique code.⁴¹ At least a portion of the stored profile information of the user is automatically inserted into the vendor payment form by the vendor for respective associated fields therein for presentation to the user at the user location after the insertion.⁴² Therefore, when the user receives the form for viewing, the insertion has already occurred such that the user has not viewed the form other than with already populated certain fields prior to reception.⁴³

The present invention, as set forth currently in dependent Claim 15, relates the system of Claim 14, wherein the user fills in the profile form only one time.⁴⁴

³³ See specification at reference number 2700 on Figure 27; and page 53, lines 6-11.

³⁴ See specification at page 51, lines 15-17; page 51, lines 25-26; page 52, lines 1-18; and page 53, lines 1-3.

³⁵ See specification at page 51, lines 15-17; page 52, lines 25-27; page 53, lines 1-3; page 53, lines 15-18; and page 55, lines 7-13.

³⁶ See specification at Figure 27; page 53, lines 18-21; and page 55, line 7.

³⁷ See specification at page 50, lines 22-25; page 51, lines 17-24; page 53, lines 11-26; page 54, lines 1-14; page 55, lines 24-27; and page 60, lines 5-13.

³⁸ See specification at page 50, lines 22-25; page 51, lines 17-24; page 53, lines 11-26; page 54, lines 1-14; page 55, lines 24-27; and page 60, lines 5-13.

³⁹ See specification at page 53, lines 21-25; and page 60, lines 23-26.

⁴⁰ See specification at page 53, lines 21-25.

⁴¹ See specification at page 54, lines 15-21; and page 56, lines 1-9.

⁴² See specification at page 53, lines 21-25; and page 56, lines 8-12.

⁴³ See specification at page 53, lines 21-25.

⁴⁴ See specification at page 50, lines 18-20; and pages 50, lines 25-26.

The present invention, as set forth currently in dependent Claim 16, relates the system of Claim 14, wherein the profile form is transmitted to the second location over a public switched telephone network.⁴⁵

The present invention, as set forth currently in dependent Claim 17, relates the system of Claim 16, wherein the vendor location receives the profile information from the second location in response to the vendor location transmitting the unique code to the second location.⁴⁶

The present invention, as set forth currently in dependent Claim 18, relates the system of Claim 14, wherein the unique code comprises a bar code.⁴⁷

The present invention, as set forth currently in dependent Claim 19, relates the system of Claim 14, wherein the unique code has a unique ID number associated therewith and the user provides the unique ID number to the vendor location for payment purposes.⁴⁸

The present invention, as set forth currently in dependent Claim 20, relates the system of Claim 14, wherein all of the profile information is automatically inserted into the vendor payment form as encoded information.⁴⁹

The present invention, as set forth currently in dependent Claim 21, relates the system of Claim 14, wherein only a portion of the profile information is entered into the vendor payment form as encoded information.⁵⁰

The present invention, as set forth currently in dependent Claim 22, relates the system of Claim 21, wherein the portion of the profile information is credit information.⁵¹

The present invention, as set forth currently in dependent Claim 23, relates the system of Claim 14, wherein the profile information comprises the user's name, address, ship-to address and credit information.⁵²

⁴⁵ See specification at page 53, lines 7-11; and page 55, lines 11-13.

⁴⁶ See specification at page 54, lines 11-21; and page 56, lines 1-9.

⁴⁷ See Specification at reference number 2500 on Figure 25; page 51, lines 1-3;

⁴⁸ See specification at reference number 2502 on Figure 25; page 51, lines 17-19; and page 53, lines 15-21.

⁴⁹ See specification at page 53, lines 21-25; and page 56, lines 1-9.

⁵⁰ See specification at page 54, lines 21-25.

⁵¹ See specification at page 51; lines 9-13.

The present invention, as set forth currently in dependent Claim 24, relates the system of Claim 19, wherein the second location is a central registration server having a database of the profile information associated with the respective unique code and unique ID number.⁵³

The present invention, as set forth currently in dependent Claim 25, relates the system of Claim 24, wherein the second location is a credit card company server.⁵⁴

The present invention, as set forth currently in dependent Claim 26, relates the system of Claim 14, wherein the unique code is placed on a credit card.⁵⁵

The present invention, as set forth currently in dependent Claim 27, relates the system of Claim 19, wherein the second location is a central registration server having a database of the profile information associated with the respective unique code and ID number.⁵⁶

The present invention, as set forth currently in dependent Claim 28, relates the system of Claim 1, further comprising transmitting the populated form to the vendor location to complete the on-line transaction.⁵⁷

The present invention, as set forth currently in dependent Claim 29, relates the system of Claim 14, wherein the populated form is transmitted to the vendor location to complete the on-line transaction.⁵⁸

VI. Grounds of Rejection to be Reviewed on Appeal.

Claims 1-11, 14-17, 19-24 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,005,939 to Fortenberry et al. ("*Fortenberry*") in view of U.S. Patent No. 5,960,411 to Hartman et al. ("*Hartman*"). Claims 12, 13, 18, 25, 26, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,005,939 to

⁵² See specification at page 51, lines 6-9; and page 57, lines 21-26.

⁵³ See specification at page 54, lines 15-21.

⁵⁴ See specification at page 52, lines 25-27; and page 61, lines 1-27.

⁵⁵ See specification at page 51, lines 25-26; page 52, lines 1-18; and page 53, lines 1-3.

⁵⁶ See specification at page 54, lines 15-21.

⁵⁷ See specification at page 60, lines 11-26.

⁵⁸ See specification at page 60, lines 11-26.

Fortenberry et al. (“*Fortenberry*”) in view of U.S. Patent No. 5,960,411 to Hartman et al. (“*Hartman*”) and further in view of U.S. Patent No. 6,311,214 to Rhoads (“*Rhoads*”).

As detailed below, Appellants believe that the Examiner has improperly applied the combinations of the *Fortenberry* and *Hartman* references and *Fortenberry*, *Hartman*, and *Rhoads* references to claims 1-29. Specifically, Appellants submit that the §103 rejections based on the combinations of *Fortenberry* and *Hartman* and *Fortenberry*, *Hartman*, and *Rhoads* are not proper and are without basis, and that the Examiner has failed to state a *prima facie* case as to the combinations of *Fortenberry* and *Hartman* and *Fortenberry*, *Hartman*, and *Rhoads* constituting a viable combination of references under 35 U.S.C. § 103.

VII. Argument and Discussion.

In order to prevail, Appellants must show that Examiner has improperly combined *Fortenberry* and *Hartman* and *Fortenberry*, *Hartman*, and *Rhoads* in support of the 35 U.S.C. § 103 and has failed to present a *prima facie* case of obviousness. As such, a brief discussion of the relevant rules and recent court decisions affecting a proper rejection under 35 U.S.C. § 103 follows.

A. Rejections under 35 U.S.C. §103

MPEP § 2142 specifies that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

In regard to what an examiner must show in order to establish a *prima facie* case of obviousness, MPEP § 2142 further explains that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In regard to what an examiner must do in order to meet the first criterion for a *prima facie* rejection, MPEP § 2143.01 specifies that:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In the present application, the various combinations of references proposed by the Examiner are not supported by a proper suggestion or motivation to make each proposed modification. This means that the first criterion for a *prima facie* rejection has not been met, which in turn means the Examiner has failed to carry the burden of establishing a *prima facie* rejection. In addition, certain claim limitations are not taught or suggested by the cited combinations, which means that the third criterion for a *prima facie* rejection has not been met, and that the Examiner has further failed to carry the burden of establishing a *prima facie* rejection for this independent reason. Further, the Examiner has failed to put forth any arguments and has not provided any articulated reasoning as to how any deficiency (missing element) could be solved in a predictable manner through combination with any other reference.

B. Recent Decisions Affecting a Finding of Obviousness.

1. In re Kahn.

With respect to obviousness, a claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.”⁵⁹ Obviousness is a question of law, based upon underlying factual questions which are reviewed for clear error following a bench trial. These “underlying factual inquiries include: (1) The scope and content of the prior art; (2) The level of ordinary skill in the prior art; (3) The difference between the claimed invention and the prior art; and (4) Objective evidence of nonobviousness.”⁶⁰

⁵⁹ 35 U.S.C. § 103(a) (2000); *In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S.1, 13-14, 86 S.Ct. 684, 15L, Ed. 2d 545, 1962)

⁶⁰ *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

In *Kahn* the Court noted that:

“ . . . to reject claims in an Application under § 103, an Examiner must show an un rebutted *prima facie* case of obviousness . . . on appeal to the board, an Applicant can overcome a rejection by showing insufficient evidence of a *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”⁶¹

When combining references, it is well recognized that “[m]ost inventions arise from a combination of old elements and each element may often be found in the prior art.”⁶² “However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.”⁶³ *Kahn* further states:

Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this requires that the Board “explain the reasons one of the ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” *Id. at 1357-59.* This entails consideration of both the “scope and content of the prior art” and the “level of ordinary skill in the pertinent art” aspects of the Graham test.⁶⁴

The primary test that has been put forth by the Federal Circuit is the teaching-suggestion-motivation test. *Kahn* set forth that, when there is no explanation provided by the Board to explain the motivation, or the suggestion or the teaching, that would have led a skilled artisan at the time of the invention to the claimed combination as a whole, then the court would infer that hindsight was utilized to conclude that the invention was obvious. *Kahn* relied upon the *Rouffett* case for this teaching at 1358. The “teaching-suggestion-motivation” requirement was set forth to protect against the entry of hindsight into the obviousness analysis, a problem which §103 was meant to confront. Thus, in order to establish a *prima facie* case, some explanation as to teaching, suggestion, or motivation of each of the references and how they can be combined is required.

⁶¹ *Kahn*, 441 F.3d at 985

⁶² *In re Rouffett*, 149 F.3d 1350, 1357

⁶³ *Kahn*, 441 F.3d at 986, citing *Rouffett*, 149 F.3d at 1355, 1357

⁶⁴ *Kahn*, 441 F.3d at 986.

Although *Kahn* sets forth the teaching-suggestion-motivation test, there is still the “analogous-art” test that must be applied, this being one test that was articulated by the Supreme Court as part of the *Graham* analysis.⁶⁵ “The analogous-art test requires that the Board show a reference is either in the field of the Applicant’s endeavor or is reasonably pertinent as to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.”⁶⁶ The following was further stated by *Kahn*:

References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“It is necessary to consider the reality of the circumstances, in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See *id.*; *In re Clay*, 996 F.2d 656, 659-60 (Fed. Cir. 1992).⁶⁷

As such, the first step of analyzing the combination provided by the Examiner is to examine the references and determine if the combination satisfies the analogous-art test. The next step for determining obviousness is to analyze the teaching-suggestion-motivation test which:

... picks up where the analogous art test leaves off and informs the *Graham* analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, [**23] or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see § 103(a); *Graham*, 383 U.S. at 35; *Dann*, 425 U.S. at 227-29, and helps ensure predictable patentability determinations.⁶⁸

⁶⁵ See *Dann v. Johnston*, 425 U.S. at 219, 226, 96 S.Ct. 1393, 47 L.Ed 2d 692 (1976).

⁶⁶ *Kahn*, 441 F.3d at 987.

⁶⁷ *Id.*

⁶⁸ *Kahn*, 441 F.3d at 987.

Even if all of the elements of a claim are disclosed in various prior art references, the long-standing rule that a claimed invention, as a whole⁶⁹, cannot be said to be obvious unless there is some reason or motivation given in prior art why someone would have been prompted to combine the teachings or the references.⁷⁰ The prior art itself may suggest desirability of a combination, or the motivation may come from other sources (for example, economic factors).⁷¹ Thus, the motivation to combine the relevant art or teachings does not have to be found explicitly in the prior art but, rather, can be implicit thereto. “However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”⁷² The purpose of such requirement is to ensure “due process and non-arbitrary decision making”, as it is in § 103.⁷³

Kahn articulated the considerations for motivation when analyzing obviousness. The Court stated “the problem examined is not the specific problem solved by the invention, but the general problem that confronted the inventor before the invention was made.”⁷⁴ In the reference in *Cross*, the quote that was cited by the Court⁷⁵ was that “one of ordinary skill in the art need not see the identical problem addressed in the prior art reference to be motivated to apply its teachings.” As to motivation, the Courts upheld that the evidence of motivation to combine the prior art references “may flow from the prior art references themselves, knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.”⁷⁶ *Kahn* summarized the motivation-suggestion-teaching test as follows:

Therefore, the “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of

⁶⁹ *In re Hirao*, 535 F.2d, 67, (C.C.P.A. 1966).

⁷⁰ *In re Regel*, 526 F.2d, 1399 (C.C.P.A. 1975); *In re Bond*, 910 F.2d, 831, (Fed. Cir. 1990).

⁷¹ See e.g. *In re Clinton*, 527 F.2d 1226 (C.C.P.A. 1976); *Cable Elec. Prods., Inc. v. Genmart, Inc.*, 77 F.2d, 1015 (Fed. Cir. 1985).

⁷² *Kahn*, 441 F.3d at 998 referring to *Lee*, 277, F.3d at 1343-46 and *Rouffett*, 149 F.3d at 1355-59. It is noted that the Supreme Court in the recently decided case, *KSR International Co. v. Teleflex Inc.*, et al., 127 S. Ct. 1727 (2007) cited this specific language at page 1741 therein.

⁷³ *Id.* referring to *Lee*, 277, F.3d at 1343-46 and *Rouffett*, 149 F.3d at 1355-59.

⁷⁴ *Kahn*, 441 F.3d at 998, referring to *Cross Medical Products, Inc. v. Metronics Sofamore Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005).

⁷⁵ *Cross*, 424 F.3d at 1323.

⁷⁶ *Medichem S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir 2006), quoting *Brown and Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d, 1120, 1125 (Fed. Cir. 2000).

ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See *Cross Med. Prods.*, 424 F.3d at 1321-24. From this it may be determined whether [**26] the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art—i.e., the understandings and the knowledge of persons having ordinary skill in the art at the time of the invention—support the legal conclusions of obviousness. See *Princeton Biochemicals*, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).⁷⁷

In *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286 (Fed. Cir. 2006), the Federal Circuit has responded to arguments made during pendency of the recently decided Supreme Court case, *KSR International Co v. Teleflex Inc., et al.*, 127 S. Ct. 1727 (2007) and has spelled out its law on obviousness, insisting that it is in harmony with Supreme Court precedent.

In the facts of this case, *Alza* sued Mylan for infringement of its patent (6,124,355) under 35 U.S.C. §271(c)(2) after Mylan sought FDA approval to market a generic version of oxybutynin, a drug used to treat urinary incontinence. The Federal Circuit affirmed the obviousness and non-infringement decisions of the district court.

In the process, Judge Arthur Gajarsa dedicated five pages of his opinion to then outline the Federal Circuit's law on obviousness, responding to many arguments made in the then pending Supreme Court case of *KSR Int'l Co. v. Teleflex, Inc.* (U.S. No. 04-1350). *KSR* and many amici, including the U.S. government, have challenged the Federal Circuit rule that proof of obviousness must include a showing of a "teaching, suggestion, or motivation" to combine the prior art elements of the claimed invention. *KSR* and others have said that this requirement is too rigid and is inconsistent with Supreme Court decisions issued since *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Judge Gajarsa wrote the following in his *Alza* opinion:

⁷⁷ *Kahn*, 441 F.3d at 988.

This requirement has been developed consistent with the Supreme Court's obviousness jurisprudence as expressed in *Graham* and the text of the obviousness statute that directs us to conduct the obviousness inquiry "at the time the invention was made" 35 U.S.C. §103. As we explained in [*In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006)],

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law . . .

441 F.3d at 987. We further explained that the "motivation to combine" requirement "[e]ntails consideration of both the 'scope and content of the prior art' and 'level of ordinary skill in the pertinent art' aspects of the *Graham* test." *Id.* at 986.

At its core, our anti-hindsight jurisprudence is a test that rests on the unremarkable premise that legal determinations of obviousness, as with such determinations generally, should be based on evidence rather than on mere speculation or conjecture. Our court's analysis in *Kahn* bears repeating:

A suggestion, teaching, or motivation to combine the relevant prior art teachings *does not have to be found explicitly in the prior art*, as "the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references.... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be *some* articulated reasoning with *some* rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of Board determinations], which ensures due process and non-arbitrary decision making, as it is in § 103.

441 F.3d at 987-88 (quoting *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)) (citations omitted) (emphases added). There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine before concluding that one of ordinary skill in the art would know to combine references. This approach, moreover, does not exist merely in theory but in practice, as well. Our recent decisions in *Kahn* and in [*Cross Med. Prods., Inc., v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293 (Fed. Cir. 2005)] amply illustrate the current state of this court's views.⁷⁸

2. KSR

The recently issued Supreme Court Case in *KSR* held that the Federal Circuit's Teaching, Suggestion or Motivation (TSM) test to combine known elements in order to show that the combination is obvious is too rigid. The Court reinforced their position that analysis under *Graham* has been reaffirmed. The Court indicated that its holding was that a "patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men."⁷⁹ The Court stated that this was a "principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."⁸⁰ The Court further went on to indicate that there were three cases that illustrated the application of this doctrine of predictability. The first case was *United States v. Adams*, 383 U.S. 39, 40 (1966). In discussing this case, the Court noted that it had "relied upon the corollary principal that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."⁸¹ In the second case, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), the Court reiterated "while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented."⁸² In the third case, *Sakraida v. AGPro, Inc.*, 425 U.S. 273 (1976), the Court stated that "when a patent 'simply arranges old

⁷⁸ *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286, 1290 (Fed. Cir. 2006).

⁷⁹ *KSR*, 127 S. Ct. 1727, 1739 (2007), Citing *Great Atlantic & Pacific Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950).

⁸⁰ *Id.*

⁸¹ *KSR*, 127 S. Ct. at page 1740.

⁸² *Id.*

elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious."⁸³

The Court summarized these three cases as follows:

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. *If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.* For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.⁸⁴ (Emphasis added.)

The Court recognized that following the above stated principals might involve more than “the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.”⁸⁵ The Court noted that it might “be necessary for a Court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent that issued.”⁸⁶ However, the Court also noted that the analysis should be “made explicit” citing *Kahn* wherein it stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reason with some rational underpinning to support the legal conclusion of obviousness.”⁸⁷ The Court noted that, however, “the analysis need not seek out precise teachings directed to the specific subject matter of the

⁸³ *Id.* at page 1740 Citing *Sakraida* at 282.

⁸⁴ *Id.* at page 1741.

⁸⁵ *Id.*

⁸⁶ *KSR*, 127 S. Ct. at page 1741.

⁸⁷ *Id.*

challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”⁸⁸

Although the Court in this opinion rejected the rigidity of the TSM test, there was some reference to the decision in *Alza* wherein the Court noted the Federal Circuit’s position that “there is flexibility in our obviousness jurisprudence because the motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine . . . ,” citing *Alza*, 464 F.3d at 1291.⁸⁹ However, the Court also noted that the *Alza* decision was not before it and that, although they may describe an analysis more consistent with the Court’s earlier precedence, the Court of Appeals would have to consider the current decision in view of its future cases.

C. 35 U.S.C § 103 Rejection in the Application on Appeal.

The Examiner stated in the Final Office Action dated May 18, 2006:

In regards to claim 1-11, 14-17, 19-24 and 27 the combination of Fortenberry and Hartman teach [sic] a method of processing profile information of a user for conducting an on-line transaction between the user and a vendor (abstract), comprising the steps of:

entering profile information of a user into a profile form at a user location disposed on a network prior to conduction of an on-line transaction between the user and the vendor (col 7, lines 39-45),

the vendor disposed at a vendor location on the network (2a, item 210);

issuing to the user a unique code representing stored profile information of the user in response to the user transmitting the profile form from the user location to a second location on the network for storage thereat (col 7, lines 45-65),

the second location disposed on the network (FIG 2a, item 216);

initiating an on-line transaction by selecting a product of the vendor at a user location (col 8, lines 29-31);

after selecting the product, providing to the vendor location by the user the unique code for purchase of the product during the on-line transaction (col 8, lines 31-33),

⁸⁸ *Id.*

⁸⁹ *Id.* at page 1743.

providing the stored profile information from the second location to the vendor location in response to the vendor location receiving and processing the unique code (col 8); and

... Hartman teaches automatically filling [sic] a confirmation webpage at a server which includes user sensitive information for processing the order (FIG 6 and 1C).⁹⁰

Appellants submit that the Examiner simply has broken Appellants' invention into its component parts and then attempted to find a prior art reference corresponding to each component to support an obviousness rejection under 35 U.S.C. § 103. Additionally, the Examiner has not provided a reference, nor directed Appellants to a teaching in the cited references, for an on-line transaction that requires the user to view a vendor payment form, at the user location, representing information about the transaction, and which vendor payment form includes fields that are associated with the information obtainable from the stored profile information of the user and which must be viewed by the user prior to completion of the on-line transaction as required by Claims 1 and 14 of the instant application. In order to establish a *prima facie* case of obviousness using the combinations of *Fortenberry* and *Hartman* and *Fortenberry*, *Hartman* and *Rhoads*, the Examiner must first show that each of the references is analogous prior art and then provide an explanation as to whether the overall disclosures of the references, the teachings therein and the suggestions associated therewith, in addition to the level of skill in the art, support a conclusion of obviousness as it relates to the entire invention. Appellants submit that the Examiner's combinations of *Fortenberry* and *Hartman* and *Fortenberry*, *Hartman* and *Rhoads* are conclusory, and that no articulated reasoning with some rational underpinning to support the combinations has been provided. Further, Appellants submit that support for the combinations is based on hindsight and that the combinations are improper.

1. Independent Claim 1 as rejected by the combination of *Fortenberry* and *Hartman*.

In the Final Office Action mailed April 05, 2007, the Examiner maintains his 35 U.S.C. § 103 rejection of Claims 1-11, 14-17, 19-24 and 27. On page 4 of the Final Office Action the Examiner states:

⁹⁰ See Final Office Action mailed April 05, 2007, pages 3-4.

Fortenberry teaches passing information from a third party to a vendor to process a transaction after receiving a unique identifier authorizing the release of sensitive information to a vendor (col 8, lines 29-31), ...⁹¹

The Examiner further states that “[*Fortenberry*] does not specifically mention inserting released information into a form automatically before submittal to a user. Hartman teaches automatically filling a confirmation webpage at a server which includes user sensitive information for processing the order (FIG 6 and 1C). It would have been obvious to a person having ordinary skill in the art at the time of the invention to generate the web page at the vendor and sending it to the user, because this will be more efficient by eliminating a step and the need for additional software for filling in the web page on the user computer after sending information to the user and sending the web page to the user separately. Further, it would have been obvious to a person having ordinary skill in the art at the time of the invention to include in *Fortenberry* the confirmation page of Hartman, because this was a notoriously well known means for presenting a final order summary that assures the user that the vendor has the order correct.”⁹²

2. The Cited References – Teaching/Suggestion/Motivation Test.

One step for determining obviousness is to analyze under the teaching-suggestion-motivation test. As previously discussed, the recent *KSR* Supreme Court case indicated that the Teaching-Suggestion-Motivation (TSM) test is not a rigid test; however, it is still considered to be a factor. Under this test, each of the references must contain some type of teaching, as well as some type of suggestion, to allow for the combination. One also must be motivated to combine the references. If this test alone were utilized, the questions that must be answered are whether *Fortenberry* and *Hartman* contain any teaching that would suggest to one skilled in the art to combine these three references to overcome the problem addressed by the present application, and whether any motivation to so combine exists.

a. Discussion of Fortenberry – TSM Test

The Examiner has utilized the TSM test to support the rejection of the claims and has provided *Fortenberry* as the primary reference to support the 35 U.S.C. § 103 rejection.

⁹¹ See Final Office Action mailed April 05, 2007, page 4.

⁹² See Final Office Action mailed April 05, 2007, page 4.

Fortenberry is directed toward the concept of facilitating access to an internet website. *Fortenberry* described the technique for conducting business over a public computer network. A stated example illustrates how a user, making a purchase or conducting a transaction over the internet, is required to make a purchase/transaction request followed by input of information such as user name, address, social security number, credit card number, etc.⁹³ *Fortenberry* identifies a problem of the user having to re-enter the same information for multiple requests, as this could possibly lead to mistakes in entering the information. As such, *Fortenberry* seeks to provide a technique for allowing a user to specify particular information once and have the information be used each time the user accesses any site on the public network.⁹⁴ *Fortenberry* teaches that a user makes a request to a passport agent (216) to generate a passport.⁹⁵ The passport agent can be an object oriented database management system.⁹⁶ The passport agent (216) provides a series of menus as queries to user. In response, the user enters information and a corresponding level of security to protect the information.⁹⁷ Then the passport agent (216) provides a public key to enable the user to access the passport data. Thereafter, the passport data is stored in a highly secured site on the internet.⁹⁸

In operation, the user who wishes to conduct a transaction with a vendor, requests a transaction with at the vendor website. The user provides the vendor the public key. Next, the user requests the passport agent to release the specific user information to the website. The passport agent sends the user information as encrypted data, using a private key. The vendor uses the public key to unlock and decrypt the passport data.⁹⁹

As such, it can be seen that the primary goal of *Fortenberry* is to facilitate a user to pre-store information, such as profile information, and have that information available each time the user accesses a site on the public network. This information can be reused without the requirement to re-enter the information during the purchase/transaction.

⁹³ See *Fortenberry*, Col. 1, lines 13-22.

⁹⁴ See *Fortenberry*, Col. 1, lines 44-47.

⁹⁵ See *Fortenberry*, Col. 7, lines 39-45.

⁹⁶ See *Fortenberry*, Col. 6, lines 8-14.

⁹⁷ See *Fortenberry*, Col. 7, lines 45-59.

⁹⁸ See *Fortenberry*, Col. 7, lines 59-67.

⁹⁹ See *Fortenberry*, Col. 8, lines 23-67.

Independent Claim 1 of the instant application, as currently presented, is directed to processing profile information of a user for conducting an on-line transaction between the user and a vendor. The first step is to enter profile information of a user into a *profile form at a user location* disposed on a network prior to conduction of an on-line transaction between the user and the vendor. The Examiner contends that the combination of *Fortenberry* and *Hartman* teaches this element of Claim 1 at (col 7, lines 39-45).¹⁰⁰ Although this citation and the others cited by the Examiner do not state the cited reference, Appellants believe that the citations are from *Fortenberry*. The corresponding section from *Fortenberry* reads:

First, the user sends a request to generate a passport to passport agent 216, as illustrated by process step 400. The passport agent receives the request, as illustrated by process step 402, and opens a secure communication channel between the passport agent and the requesting user, as illustrated by process 404.¹⁰¹

This citation contains no teaching for a user entering profile information into a *profile form at a user location* disposed on a network. This portion of *Fortenberry* teaches the user sending a request to a central location in order to create what is termed a “passport.” *Fortenberry* does not teach a profile form, at a user location, for entry of user profile information. *Fortenberry* discloses that the “[p]assport agent 216 presents to the user a series of queries which may be in the form of menus, as illustrated by process block 406. In response, the user enters the requested information ...”¹⁰² Clearly, if a form existed, the form would exist at the passport agent (216), not the user location. The mischaracterization of the *Fortenberry* passport agent menu system as a profile form at a user location is clear error.

Claim 1 also requires that the vendor disposed at a vendor location on the network. *Fortenberry* does disclose a vendor website located on the internet; however, Claim 1 further recites issuing to the user a unique code *representing* stored profile information of the user *in response to the user transmitting the profile form* from the user location to a second location on the network for storage thereat, the second location disposed on the network. The Examiner

¹⁰⁰ See Final Office Action mailed April 05, 2007, page 3.

¹⁰¹ See *Fortenberry*, Col. 7, lines 39-45.

¹⁰² See *Fortenberry*, Col. 7, lines 45-48.

provides *Fortenberry*, column 7, lines 45-65 for this teaching. The cited portion of *Fortenberry* states:

Passport agent 216 then presents to the user a series of queries which may be in the form of menus, as illustrated by process block 406. In response, the user enters the requested information such as social security number, drivers license number, etc., and a corresponding level of security to protect the information item, as illustrated by process blocks 408 and 410. The user specified information is referred to herein as user information or environmental variables. The security levels assigned to each item of user information or environment variables range from highly secure to public. For example, particularly sensitive information may be designated as highly secured and assigned a high security level of 100 on an exemplary scale of 0-100 levels. Less sensitive information may be designated as less secured or even public and assigned a lower security level approaching or equal to zero. Next, *passport agent 216 provides a public key to the user to access the passport data*, as illustrated by process 418. Finally, the user's information which collectively comprises the Internet passport is stored and maintained in a highly secured server site on the Internet which serves as the passport agent and guarantees the integrity of the users passport, as illustrated by process block 420.¹⁰³ (*emphasis added*)

In this portion of the specification, *Fortenberry* discloses the series of queries that are provided to the user allow the user to input the information. First, *Fortenberry* contains no disclosure that the user fills out and transmits a form from the user location. As stated herein, if a form existed, the form would exist at the passport agent location. As such, *Fortenberry* is incapable of issuing a unique code *in response to the user transmitting the profile form from the user location* to a second location on the network.

Second, *Fortenberry* contains no disclosure that illustrates the unique code as recited the Independent Claim 1 of the instant application. Claim 1 requires that the unique code is issued to the user and this code *represents* the stored profile information of the user. *Fortenberry* discloses the generation of an encryption security key, in the form of a public key, to the user that the user may utilize later when allowing a vendor to access profile information. *Fortenberry*

¹⁰³ See *Fortenberry*, Col. 7, lines 45-65.

teaches that the public key is used to “unlock and decrypt” the passport data. As such, the public key, though unique, is not a unique code *representing* the stored profile information. The public key is a security key¹⁰⁴ which, at best, relates to the encryption algorithm (private key), not the stored profile information. The unique code, as recited in the claims of the instant application, identifies the stored profile information. The public key merely decrypts an encrypted file after the vendor receives the file. The Examiner’s use of a security key, found in *Fortenberry*, as a unique code representing stored profile information is clear error.

Claim 1 further recites initiating an on-line transaction by selecting a product of the vendor at a user location. The Examiner provides column 8, lines 29-31¹⁰⁵ for this teaching wherein *Fortenberry* states that “the user requests a transaction with a particular vendor, i.e., website **210**.”¹⁰⁶ Clearly, all that *Fortenberry* discloses is a user’s *request* to initiate some sort of transaction with a vendor. *Fortenberry* contains no disclosure that the user initiates an on-line transaction by *selecting a product of the vendor* at a user location.

Additionally, Claim 1 recites, after selecting the product, providing to the vendor location, by the user, the unique code for purchase of the product, during the on-line transaction, which on-line transaction requires the user to view a vendor payment form at the user location representing information about the transaction, and which vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user and which must be viewed by the user prior to completion of the on-line transaction. The Examiner contends *Fortenberry* teaches “after selecting the product, providing to the vendor location, by the user, the unique code for purchase of the product, during the on-line transaction” at column 8, lines 31-33.¹⁰⁷ However, as stated herein, the Examiner provides no reference to teach an “on-line transaction requires the user to view a vendor payment form at the user location representing information about the transaction, and which vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user

¹⁰⁴ See *Fortenberry*, Col. 8, lines 1-15.

¹⁰⁵ See Final Office Action mailed April 05, 2007 at page 3.

¹⁰⁶ See *Fortenberry*, Col. 8, lines 29-31.

¹⁰⁷ See *Fortenberry*, Col. 8, lines 31-33.

and which must be viewed by the user prior to completion of the on-line transaction” as required by the claim.

Further, *Fortenberry* does not disclose “after selecting the product, providing to the vendor location by the user the unique code for purchase of the product during the online-transaction” as contended by the Examiner.¹⁰⁸ Column 8, lines 31-33 states that “next, the user provides a public key to the vendor, as illustrated in process block 504.” The public key was previously provided to the user by passport agent 216. *Fortenberry* discloses the process by which the passport is sent to the vendor wherein *Fortenberry* reads:

Referring now to FIG. 2B, in general overview, the passport system operates in the following manner. *User 208 who wishes to conduct a transaction at web site 210 requests that passport agent 216 release specific user information to web site 210.* The request is made as an encrypted message to passport agent 216. Passport agent 216 has previously been provided a key with which to decrypt the encrypted message from user 208. Passport agent 216 decrypts the request from user 208 to determine, inter alia, the particular web site to which a passport of the user 208 should be sent.

Passport agent 216 then provides encrypted data to the particular web site here denoted as web site 210. *User 208 has previously provided to web site 210 a public key with which web site 210 can decode the encrypted data provided by passport agent 216.*¹⁰⁹ *(emphasis added)*

Fortenberry teaches that when a user desires a transaction with a vendor, the user provides the public key to the vendor and requests the passport agent to send encrypted data. The vendor is able to use the public key to decrypt the data. *Fortenberry* contains no disclosure for the selection of a product. Additionally, *Fortenberry* does not teach a unique code as required by the claims of the instant application. The claims of the instant application require that the unique code is provided to the vendor for the purchase of a product during the on-line transaction. Clearly, no disclosure exists in *Fortenberry* for providing to the vendor, the unique

¹⁰⁸ See Final Office Action mailed April 05, 2007, at page 3.

¹⁰⁹ See *Fortenberry*, Col. 6, lines 15-29.

code after selection of the product, wherein the user provides the unique code for the purpose of purchasing the product during the on-line transaction.

Thereafter Independent Claim 1 recites “providing the stored profile information from the second location to the vendor location *in response to the vendor location receiving and processing the unique code.*” The Examiner merely states that this is all disclosed in column 8. However, the best description of the process flow is found where *Fortenberry* describes Figure 2b (cited above). The portion of the specification associated with the description of Figure 2b begins at column 6, line 15 and extends to line 46. That portion of the specification is set forth as follows:

Referring now to FIG. 2B, in general overview, the passport system operates in the following manner. *User 208 who wishes to conduct a transaction at web site 210 requests that passport agent 216 release specific user information to web site 210.* The request is made as an encrypted message to passport agent 216. Passport agent 216 has previously been provided a key with which to decrypt the encrypted message from user 208. Passport agent 216 decrypts the request from user 208 to determine, inter alia, the particular web site to which a passport of the user 208 should be sent.

Passport agent 216 then provides encrypted data to the particular web site here denoted as web site 210. User 208 has previously provided to web site 210 a public key with which web site 210 can decode the encrypted data provided by passport agent 216.

The web site 210 receives the encrypted user information (i.e. the passport) from passport agent 216 and unlocks the message using the public key provided by the user 208. If the web site 210 is unable to unlock any of the environment variables in the passport, the request is ignored, as explained hereinafter.

It should be noted that user 208 can provide to web site 210 one of several public keys which allow web site 210 to unlock data having one of several security levels. For example, user 208 may have a first key which unlocks confidential user information in the user passport, a second key which unlocks secret user information in the user passport and a third key which unlocks top secret user information in the user passport. Thus, to unlock all the data in the passport, user 208 would have to provide to web site 210 all three

keys.¹¹⁰ (*emphasis added*)

Clearly, the passport agent provides some sort of data to the vendor in the form of an encrypted file. However, *Fortenberry* expressly teaches that the user contacts the passport agent and requests that the passport agent send the encrypted data to the vendor. As such, the data is sent to the vendor in response to the user's request made to the passport agent. The data is not sent in response to the vendor location receiving and processing the public key. First, *Fortenberry* does not teach, and cannot be interpreted to teach, a causal relationship between the vendor receiving the public key and the passport agent providing the encrypted data to the vendor. The vendor receives the passport data only because the user is required to, separately, go out and request that the passport agent send the passport data to the vendor. The vendor does not receive the passport data *in response* to receiving the public key. Second, *Fortenberry* does not teach, and cannot be interpreted to teach, that the vendor *processes* the public key. *Fortenberry* expressly teaches, and is limited to teaching, that the vendor *uses* the public key to decrypt the encrypted data *after* the vendor receives both the public key and the encrypted data. A further example of the lack of causal relationship and processing exists where *Fortenberry* discloses a situation where the public key is inoperable. The relevant portions of *Fortenberry* state:

The web site 210 receives the encrypted user information (i.e. the passport) from passport agent 216 and unlocks the message using public key provided by the user. If the web site 210 is unable to unlock any of the environment variables in the passport, the request is ignored, as explained hereinafter.¹¹¹

When the vendor, i.e., the web server receives passport data from the passport agent 216, and such user information is encrypted, the public key sent by the user is used to unlock and decrypt the passport data, as illustrated by the decisional block 518 and process block 520. *If the public key does not unlock the passport data, the vendor simply ignores the users request.*¹¹² (*emphasis added*)

¹¹⁰ See *Fortenberry*, Col. 6, lines 15-46.

¹¹¹ See *Fortenberry*, Col. 6, lines 31-36.

¹¹² See *Fortenberry*, Col. 8, lines 59-65.

As such, *Fortenberry* teaches that if the public key does not unlock the encrypted data, the user's request is ignored. Clearly, the vendor still receives the encrypted data even if the wrong key is provided. As such, *Fortenberry* teaches a concept opposite from providing a causal relationship between the public key and the providing of data to the vendor. However, according to the claims of the instant application, if the vendor receives the wrong unique code, or the unique code cannot be processed, the vendor never receives the profile information of the user. Receiving and processing of the unique code, by the vendor, initiates the providing of stored profile information from the stored location to the vendor location. Therefore, the Examiner's reliance on *Fortenberry* to teach this element of the Claim 1 is clear error.

Appellants and the Examiner agree that *Fortenberry* is deficient in teaching "automatically inserting by the vendor at least a portion of the stored profile information of the user into the vendor payment form for respective associated fields therein for presentation to the user at the user location after such insertion such that, when the user receives the form for viewing, such insertion has already occurred, such that the user has not viewed the form other than with already populated certain fields prior to reception" as found in Claim 1 of the instant application. Furthermore, *Fortenberry* contains no suggestion or teaching for presenting, to the user, a vendor payment form wherein the profile information of the user has already been inserted into the respective associated fields or that such would be useful for its intended purpose. *Fortenberry* teaches that once the vendor accesses the personal information, i.e., decrypts the encrypted data file using the public key, the vendor contacts the financial institution (if a purchase is the transaction that the user sought), authenticates the user and completes the purchase.

Thus, to apply *Fortenberry* for the purpose of rendering obvious Claim 1 in the present application, the Examiner must show that *Fortenberry* contains a teaching, suggestion, or motivation to solve the problem solved by Appellants' present claims. *Fortenberry* must also suggest that, at the time of the invention, a problem existed that could be solved by providing a vendor payment form, and that the vendor payment form could be utilized in the *Fortenberry* system for the purpose of automatically inserting stored profile information of the user into the payment form for presentation to the user in order to complete the purchase of a product by the

user. In fact, *Fortenberry* teaches away from the use of the payment form for presentation to a user and, in accordance with the corollary principle set forth in *United States v. Adams*¹¹³, “when the prior art teaches away from combining certain elements, discovery of a successful means of combining them is more likely to be non obvious.”¹¹⁴

b. Discussion of *Hartman* – TSM Test.

The Examiner concedes that the primary citation to *Fortenberry* does not disclose automatically inserting released information into a form before submittal to a user. The Examiner has provided *Hartman* to cure the deficiencies in *Fortenberry*. Specifically, the Examiner has relied on the *Hartman* to provide a teaching of inserting released information into a form automatically before submittal to a user. The Examiner indicates support for this reliance in that *Hartman* teaches automatically filling-in a confirmation webpage at a server which includes user sensitive information for processing the order (FIG 6 and 1C).¹¹⁵

Hartman teaches a method and system to facilitate the placing of an order after selection of an item is complete with a reduced number of actions.¹¹⁶ *Hartman* provides for a single-action ordering of items in a client/server environment so as to help reduce the cumbersome nature of providing information in internet transactions.¹¹⁷ A server collects purchaser-specific order information from a consumer in a number of ways.¹¹⁸ Once the information exists in a database, the user is able to use the single order system.¹¹⁹ When using the system, the user receives an initial page identifying the item the user desires to purchase along with either a single-action enable button or a single-action button. The single-action enable button activates the single-action system and, thereafter, provides a web page to the user containing the item the user desire to purchase along with the single-action button.¹²⁰ The server then provides a confirmation page for a single order, or group of orders. The confirmation web pages contain

¹¹³ See *United States v. Adams*, 383 U.S. 39, 40 (1966).

¹¹⁴ *KSR*, 127 S.Ct. at 1740.

¹¹⁵ See Final Office Action dated April 05, 2007, page 4.

¹¹⁶ See *Hartman*, Abstract; Col. 2, lines 27-48.

¹¹⁷ See *Hartman*, Col. 2, lines 27-49; and Col. 3, lines 31-37.

¹¹⁸ See *Hartman*, Col. 6, lines 39-67.

¹¹⁹ See *Hartman*, Col. 5, lines 17-20.

¹²⁰ See *Hartman*, Col. 4, line 4 – Col. 5, line 26.

essentially the same information as the ordering web page, except that an order confirmation section is included.¹²¹

The addition of *Hartman* does not teach, or render obvious, “automatically inserting by the vendor at least a portion of the stored profile information of the user into the vendor payment form for respective associated fields therein for presentation to the user at the user location after such insertion such that, when the user receives the form for viewing, such insertion has already occurred, such that the user has not viewed the form other than with already populated certain fields prior to reception” as found in Claim 1 of the instant application. Previously, Appellants outlined the deficiency of *Hartman* with regard to this limitation. Appellants stated:

In the last step, at least a portion of the stored profile information is inserted into the vendor payment form in respective fields. The only place that there is any remote suggestion of such an action is with respect to the original form that was sent to the user, as set forth in Figure 1A. In this section, section (103), there is provided a button for the transaction and, in addition thereto, other information such as address information, links to express ordering, etc. Of the information, the only information that is noted is the name of the user in position (103b). However, the requirement of this step is that, when the user receives the form (noting that this is not a payment form but, rather, an information page) for viewing after insertion, there is a requirement that this insertion follow the steps of selecting a product and then forwarding a unique code to the server for the purpose of initiating the on-line transaction, i.e., purchasing the product, and then a form sent back to the user already filled in. The information is inserted into the web page with the description of the product in *Hartman* prior to the user deciding to select that particular product. In Applicant’s present method, the present inventive concept, as defined by the amended claims, requires the selection to have already been made, and the providing of the unique code is performed during the on-line transaction.¹²²

As such, Appellants have illustrated clearly that *Hartman* does not disclose the type of payment form identified in the claims of the instant application. *Hartman* teaches, and is limited

¹²¹ See *Hartman*, Col. 4, line 64 – Col. 5, line 55.

¹²² See Response to Office Action, dated January 17, 2007, pages 14-15.

to teaching, an informational confirmation page. Thus, *Hartman* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Fortenberry*.

The Examiner has identified a particular element in the prior art, that being a web page containing information regarding a user and a purchase. *Kahn* stated that “a mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.”¹²³ Rather than concentrate on this element, the Examiner is required to articulate the basis on which the Examiner concludes that it would have been obvious to make the claimed invention, i.e., why one of ordinary skill in the art would have been motivated to select the references and to combine them in order to render the claimed invention obvious. The Examiner’s indication that a confirmation web page exists does not show the existence of such teaching. Thus, Appellants believe that the Examiner has not met a *prima facie* case by stating, “it would have been obvious ... to generate the web page at the vendor and sending it to the user, because this will be more efficient by eliminating a step and the need for additional software for filling in the web page on the user computer after sending information to the user and sending the web page to the user separately and ... because this was a notoriously well known means for presenting a final order summary that assures the user that the vendor has the order correct.”¹²⁴ *Fortenberry* teaches away from the concept of presenting information back to the user, especially for the purpose of ensuring that the vendor has the order correct, by teaching that the transaction is ignored if the public key does not match the information. As such, Appellants question why would one skilled in the art combine a confirmation page to assure a user that the order is correct in a system designed to ignore a transaction if the order is not correct?

3. Conclusion – TSM Test.

Fortenberry provides a system where a user stores personal information, called passport data, at a passport server. When the user desires to conduct commerce with a particular website, the user sends a request to a passport agent to release specific user information to the website. This request is made as an encrypted message which requires a public key. The passport agent then provides the encrypted data to the designated website and, since the user had previously

¹²³ *Kahn*, 441 F.3d at 986.

¹²⁴ See Final Office Action mailed April 05, 2007, page 4.

provided to the website the public key, the website can decode the encrypted data provided by passport agent. Therefore, the user must do two things; first, the user must send the public key to the designated website and then the user must request the passport agent to release the profile information of the user to the website. Since the website will then have the public key, the website can read the data provided thereto by the passport agent.

With respect to this particular embodiment, there are some differences between the claim language and the operation as disclosed by *Fortenberry*. First, the profile information is not entered into a profile form at a user location disposed on the network. *Fortenberry* discloses that the user enters the profile information directly into the website of the passport agent and, after entry of the information, a unique code, in the form of a public key, is then forwarded to the user.

Next, *Fortenberry* teaches that a public key is issued to the user when the user enters profile information into the passport server. However, the public key, as disclosed by *Fortenberry*, is not the “unique code” as recited in the claims of the instant application. The passport server provides the public key for the purpose of unlocking and decrypting the encrypted passport data. The public key is merely a security mechanism and *Fortenberry* specifically discloses it as such. The public key does not *represent* the stored profile information. The unique code, in the instant application, provides a reference in order to access a specific location and receive the stored profile data. The public key is incapable of accessing and receiving the data. The public key merely unlocks and decrypts an encrypted file.

Additionally, *Fortenberry* contains no disclosure that an on-line transaction is initiated by “selecting” a product of a vendor at a user location. *Fortenberry* only discloses that a user requests a transaction with a particular vendor, with no disclosure of the selection of any product. *Fortenberry* discloses that, after a transaction is requested, the next step is to provide a public key to the vendor. The user then requests the passport agent to send the user’s passport to the vendor. However, there is no step of selecting the product.

Further, the claim requires that the stored profile information be provided from the second location to the vendor location “in response to” the vendor location receiving and processing the code. *Fortenberry* does not teach, or suggest, a requirement to process the code

by the vendor in order for the vendor location to receive the stored profile information. Rather, *Fortenberry* teaches that the user must go outside and actually take some action to cause the location at which the stored profile information is stored to send this information to the vendor. The public key is only utilized to decrypt the information once it is received. Therefore, *Fortenberry* cannot teach the portion of the claim that states “in response to” with respect to the step of providing. In fact, *Fortenberry* takes a completely different approach, in that *Fortenberry* specifically requires the user to go out and make a specific request to the passport agent to send the information to the particular website of the vendor. There is no suggestion or teaching in *Fortenberry* that would lead one skilled in the art to change the operation wherein the user in *Fortenberry* sends a public key to the vendor and then sends a request to the passport agent to send the passport to the vendor to allow a previously requested transaction to go forward. The claim clearly requires that the stored profile information is a function of the vendor location receiving and processing the unique code. The vendor location will not even utilize the unique code until it receives the profile information. Therefore, the profile information has to be received before the unique code is even used.

Hartman teaches a system that provides a user with confirmation web pages when the user conducts an online transaction using a single-action transaction. *Hartman* does not teach presenting a vendor payment form to the user in a manner as required by the claims of the instant application. Therefore, no reason, motivation or suggestion exists to combine *Fortenberry*, with *Hartman*. *Hartman* has no need to provide a vendor payment form for presentation to a user in the system of *Fortenberry*, as the *Fortenberry* system, already uses a public key to ensure the correct file is opened. Additionally, *Fortenberry* has no need for the confirmation web pages as the user requests the appropriate information be sent to the vendor which uses the public key to access, and the vendor ignores the transaction request if the incorrect file is sent. Appellants submit that there is no teaching, motivation or suggestion that would in lead one skilled in the art to combine these references. In fact, the *Hartman* reference teaches away from providing the user a filled in form; rather, *Hartman* teaches the use of a single-action operation wherein the complete transaction is made without providing to the user a form. Furthermore, the Examiner has provided no reference that would illustrate an online transaction requiring the user to view a vendor payment form at the user location representing information about the transaction, and

which vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user and which must be viewed by the user prior to completion of the on-line transaction. Neither of the cited references, taken singularly or in combination, shows an on-line transaction as recited by the claims of the instant application. As such, even if the combination of *Fortenberry*, and *Hartman* were proper, which Appellants believe it is not, that combination fails to disclose the whole invention as set forth in Claim 1.

Based upon the TSM test, the Examiner's position is conclusory. The Examiner states that the combination of *Fortenberry* and *Hartman* would provide a system where the user initiates an on-line transaction by selecting a product of the vendor; provides a unique code, during the on-line transaction, representing a stored profile information of the user; wherein the vendor processes the unique code in order to receive the stored profile information a second location; and where the vendor automatically inserts a least a portion of the stored profile information into the vendor payment form for respective associated fields for presentation to the user. However, the Examiner has provided no articulated reasoning why one skilled in the art would use a confirmation page with a system that was designed to ignore a request if the incorrect information was provided. Additionally, the Examiner has failed to provide a reference that would illustrate an on-line transaction requiring the user to view the vendor payment form prior to completion of the on-line transaction.

4. Independent Claim 14 as rejected by the combination of *Fortenberry* and *Hartman*.

Independent Claim 14 is directed to a system for processing profile information of a user for conducting an on-line transaction between the user and a vendor. The system comprises profile information of a user entered into a profile form at a user location disposed on a network. The user enters the profile information into the profile form prior to conduction of an on-line transaction between the user and the vendor. The vendor is disposed at a vendor location on the network. A unique code representing the stored profile information of the user is issued to the user in response to the user transmitting the profile form from the user location to a second location on the network. The second location, also disposed on the network, stores the profile information. The unique code is provided to the vendor location, by the user, for purchase of a

product of the vendor after the user has viewed and made a selection of the product. The user provides the unique code to the vendor during the on-line transaction, which on-line transaction requires the user to view a vendor payment form at the user location representing information about the transaction, and which vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user and which must be viewed by the user prior to completion of the on-line transaction. The profile information is provided from the second location to the vendor location in response to the vendor location processing the unique code. Further, at least a portion of the stored profile information of the user is automatically inserted into the vendor payment form by the vendor for respective associated fields therein for presentation to the user at the user location after such insertion such that, when the user receives the form for viewing, such insertion has already occurred, such that the user has not viewed the form other than with already populated certain fields prior to reception. Independent Claim 14 contains limitations as found in Independent Claim 1. Therefore, this independent claim is allowable for at least the same reasons as Claim 1.

5. Dependent Claims 2-11, 15-17, 19-24 and 27 as rejected by the combination of Fortenberry, and Hartman.

In the Final Office Action mailed April 05, 2007, the Examiner maintains his 35 U.S.C. § 103 rejection of Claim 2-11. On page 3 of the Final Office Action the Examiner states:

Claims 1-11, 14-17, 19-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry (US 6,005,939) in view of Hartman (US 5960411).¹²⁵

However, the Examiner has provided no citation, nor directed Appellants to any teaching in the references, where the various claim limitations are taught. Additionally, Claims 2-11 depend from, and further limit, Independent Claim 1. Dependent Claims 15-17, 19-24 and 27 depend from, and further limit, Independent Claim 14. These dependent claims are allowable for at least the same reasons as the claims from which they depend, as discussed above.

Claims 4 and 17 recite wherein the vendor location receives the profile information from the second location in response to *the vendor location transmitting the unique code* to the second

¹²⁵ See Final Office Action mailed April 05, 2007, page 3.

location. As stated herein, *Fortenberry* teaches that the vendor uses the public key to unlock and decrypt the encrypted data. *Fortenberry* contains no disclosure that the vendor transmits the public key.

Previously, the Examiner provided *Hartman* to teach this limitation. The Examiner stated:

In regards to claims 1, 4, 5, 6, 9, 10, 14, 15, 17-19, 22 and 23, Hartman discloses all the features of the instant claims [sic] For example, Hartman teaches sending an order form with information already inserted for viewing or changing and which has not been viewed by the user before receipt of the order form (FIG 1C).¹²⁶

Hartman Figure 1C does not illustrate the vendor transmitting the unique code to the second location. Further, *Hartman* contains no unique code. *Hartman* teaches a unique ID, stored as a “cookie” that identifies a system; however, *Hartman* does not disclose that the unique ID represents stored profile information of a user. Appellants described the stored information in *Hartman*,¹²⁷ citing the portion of the specification which reads:

The client identifier/customer table 212 contains a mapping from each client identifier, which is a globally unique identifier that uniquely identifies a client system, to the customer last associated with that client system. The client system 220 contains a browser and its assigned client identifier. The client identifier is stored in a file, referred to as a “cookie.” In one embodiment, the server system assigns and sends the client identifier to the client system once when the client system first interacts with the server system. From then on, the client system includes its client identifier with all messages sent to the server system so that the server system can identify the source of the message. The server and client systems interact by exchanging information via communications link 230, which may include transmission over the Internet.¹²⁸

Clearly, the customer is not necessarily identified; rather, it is the client system that is identified using a well-known “cookie” concept wherein a code is disposed on a user’s computer that can be retrieved whenever a connection is made to a particular server. Appellants stated that

¹²⁶ See Office Action mailed July 18, 2006, page 3

¹²⁷ See Response dated January 17, 2007, pages 10-11.

¹²⁸ See *Hartman*, Col. 6, lines 7-21.

“[o]ne problem with this type of system is that the particular user does not have the ability to actually log in or take an action of inputting verification data, i.e., user name and password; rather, anyone who accesses this web page or web site on a particular physical system or client device will identify that system as associated with that user even though the user is not that identified at the server. Thus, it is the computer that transmits the identifier and not the user.”¹²⁹

Further, not only does *Hartman* fail to disclose a unique code, as required by the claims of the instant application, but the Examiner has not provided a citation, or directed Appellants to a teaching in the references that discloses the vendor transmitting a unique code to the second location. Therefore, *Fortenberry* and *Hartman*, taken singularly or in combination, fail to teach wherein the vendor location receives the profile information from the second location in response to the vendor location transmitting the unique code to the second location. As such, the Examiner’s rejection of Claims 4 and 17 is without support and is clear error.

Claims 5, 6 and 19 recite that the unique code is unique and has a unique ID number associated therewith. Again, the Examiner has not provided a citation, or directed Appellants to a teaching to support a rejection of these claims. Further, as stated herein, *Fortenberry* teaches a public key that is used for decryption. However, *Fortenberry* contains no disclosure for a separate unique number associated to the public key. Additionally, *Hartman* uses a “cookie” as a unique ID. *Hartman*, like *Fortenberry*, contains no disclosure for a separate, unique number associated to the “cookie.” The Examiner has provided no support for the rejection of Claims 5, 6 and 19. *Fortenberry* and *Hartman*, taken singularly or in combination fail to teach that the unique code is unique and has a unique ID number associated therewith. As such, the Examiner’s rejection of Claims 5, 6 and 19 is clear error.

Claims 7 and 20 recite wherein the step of automatically inserting causes all of the profile information to be entered into the vendor payment form as encoded information; and Claims 8 and 21 recite wherein the step of automatically inserting causes only a portion of the profile information to be entered into the vendor payment form as encoded information. The Examiner

¹²⁹ See Response dated January 17, 2007, pages 10-11.

has not provided a citation, or directed Appellants to a teaching to support the rejection of Claims 7, 20 and 21, however, in regards to Claim 8, the Examiner states:

In regards [sic] claim 8, the combination of Fortenberry and Hartman teach wherein the step of automatically inserting causes only a portion of the profile information to be entered into the vendor payment form as encoded information (Hartman, FIG. 1C).¹³⁰

Again, the Examiner provides *Hartman*, Figure 1 C for this teaching. However, Figure 1C does not illustrate automatically inserting all, or a portion, of the profile information as *encoded* information. *Hartman* contains no disclosure that any information is *encoded*. Figure 1C merely illustrates a confirmation page for multiple single-action orders. The relevant portion of *Hartman* reads:

FIG. 1C illustrates the display of a Web page representing four single-action orders that have been combined into two separate multiple-item orders based on the availability of the items. The order information 106 indicates that item 1 and item 2, which will be available in three or fewer days, have been combined into one order. The order information 107 indicates that items 3 and 4, which will not be available within one week, are combined into a separate order. In one embodiment, the server system may combine single-action orders that are placed within a certain time period (e.g., 90 minutes). Also, the server system may combine or divide orders when the orders are scheduled for shipment based on the then current availability of the items ordered. This delayed modification of the orders is referred to as "expedited order selection" and is described below in detail.¹³¹

Additionally, *Hartman* discusses, in the Background, the problems regarding the interception of sensitive information. *Hartman* states that "there is always a possibility that [encrypted] sensitive information may be successfully decrypted by the interceptor. Therefore, it would be desirable to minimize the sensitive information transmitted when placing an order."¹³² *Hartman* discloses the method for securing the transmission of sensitive information by teaching:

¹³⁰ See Final Office Action mailed April 05, 2007, page 4.

¹³¹ See *Hartman*, Col. 5, lines 40-55.

¹³² See *Hartman*, Col. 2, lines 2-16.

To reduce the chances of sensitive information being intercepted, the server system sends only enough information so that the purchaser is confident that the server system correctly identified the purchaser but yet not enough information to be useful to an unscrupulous interceptor.¹³³

Clearly, *Hartman* does not disclose the encoding of all, or even a portion, of the personal information. Further, *Hartman* teaches away from encoding information by only sending a portion of information. Column 4, lines 41-46 and Figure 1C together illustrate a method wherein a portion of the information is sent, but not encoded. The Examiner's reliance on this one aspect, shown in Figure 1C, for support of the rejection is clear error. *Fortenberry* and *Hartman*, taken singularly or in combination, fail to teach where the step of inserting causes all, or a portion, of the profile information to be entered into the vendor payment form as encoded information as found in Claims 7, 8, 20 and 21.

Claims 11 and 24 recite the limitation where the second location is a central registration server. Again, the Examiner does not provide a citation or direct Appellants to a teaching of the limitations recited in these claims. Previously, the Examiner rejected Claims 11 and 24 stating:

In regards to claims 11, 12, 24, 25, and 27, the combination of *Hartman*/*Rhoads* teaches the instant claims except for the various location cited by the instant claims where the data is stored at various locations. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the database at a convenient location suitable to the usage environment, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.¹³⁴

In response, Appellants argued that *Hartman* does not describe or suggest a second location.¹³⁵ Claim 11 and 24 require that the second location is a simple registration server having a database of unique codes and unique ID numbers. However, in *Hartman*, cookies are utilized. *Hartman* teaches, and is limited to teaching, that the database associated with the cookies is disposed at the server. *Hartman* contains no teaching, suggestion or motivation that

¹³³ See *Hartman*, Col. 4, lines 41-46.

¹³⁴ See Office Action mailed July 18, 2007, page 4.

¹³⁵ See Response to Office Action dated January 17, page 17.

the cookies would be disposed elsewhere. No reason can be found why, in *Hartman*, a cookie, i.e., code, would be disposed anywhere other than on the server. *Fortenberry* merely discloses a passport agent that has a database of profile information encrypted with a private key. *Fortenberry* does not teach a central registration server, of the type required by the claims of the instant application, having a database of unique codes and unique ID numbers. As such, no teaching or suggestion exists to support the Examiner's rejection of Claims 11 and 24.

6. Dependent Claims 12 and 25 as rejected by the combination of *Fortenberry*, *Hartman* and *Rhoads*.

In the Final Office Action mailed April 05, 2007, the Examiner maintains his 35 U.S.C. § 103 rejection of Claims 12 and 25. On page 5 of the Final Office Action the Examiner states:

In regards to claims 12 and 25, the combination of *Fortenberry* and *Hartman* teach [sic] a second location, but does not specifically mention that the second location is a credit card company server. The examiner takes official notice that it was old and well known in the art at the time of the invention to utilize credit card servers as a server for storage and dissemination of credit card information. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of *Fortenberry* and *Hartman* the use of a credit card company to store and disseminated [sic] the information, because this is a notoriously well known place to store this type of information and preventing [sic] these companies from participating in the invention of *Fortenberry* would reduce the potential sales market and reduce revenues.

In the rejection, the Examiner explicitly states that Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fortenberry* in view of *Hartman* and *further in view of Rhoads (US 6,311,214)*.¹³⁶ (*emphasis added*) However, the Examiner provides, as support for the rejection, the combination of *Fortenberry*, *Hartman* and *Official Notice*. The Examiner previously offered the combination of *Hartman* and *Official Notice* to support the rejection of Claims 11, 12, 24 and 25.¹³⁷ The Examiner stated:

¹³⁶ See Final Office Action mailed April 05, 2007, page 5.

¹³⁷ See Office Action mailed July 18, 2007, page 4.

In regards to claims 11, 12, 24, 25, and 27, the combination of Hartman/Rhoads teaches the instant claims except for the various location cited by the instant claims where the data is stored at various locations. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the database at a convenient location suitable to the usage environment, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.¹³⁸

Notwithstanding the *Official Notice*, the credit card server, as recited by the instant application, is not the type that would have been well known to one of ordinary skill in the art. Claim 12 requires that the credit card server be operable to receive a unique code and unique ID number and, in response, transmit personal profile information of a user. Claim 12 depends from Claim 11. Therefore, *Hartman* also suffers the same deficiency with respect to that disclosed with respect to Claim 11. Appellants previously illustrated that *Hartman* does not disclose a second location and, as such, cannot be combined with the credit card server indicated by the *Official Notice*. Appellants stated that “*Hartman* does not in any way suggest that a second location would be utilized. To do such, would unduly complicate the system of *Hartman*, as the cookie database is typically located locally. Therefore, Applicant believes that the official notice is not proper to cure the deficiency in *Hartman*, i.e., that *Hartman* does not disclose the second location ... Merely to state that disclosure in one document stating that the location is local does not automatically suggest that the location could be stored anywhere. Applicant believes that a reference is required to support such a rejection.”¹³⁹ The Examiner has since provided *Fortenberry* but has not provided a citation or directed Appellants to where the required teaching can be found. As such, the Examiner has provided no support for the rejection of Claims 12 and 25.

7. Dependent Claims 13, 18, 26, 28 and 29 as rejected by the combination of *Fortenberry*, *Hartman* and *Rhoads*.

In the Final Office Action mailed April 05, 2007, the Examiner maintains his 35 U.S.C. § 103 rejection of Claims 13, 18, 26, 28 and 29. On page 6 of the Final Office Action the Examiner states:

¹³⁸ See Office Action mailed July 18, 2007, page 4.

¹³⁹ See Response to Office Action dated January 17, page 17.

In regards to claims 13, 18, 26, 28 and 29, the combination of Fortenberry and Hartman teach [sic] providing a unique code to the user for accessing a second server from a vendor, but does not specifically mention that the unique code is a barcode on a credit card. Rhoads teaches that the unique code is placed on a credit card (Rhoads, col 1, lines 35-40).¹⁴⁰

The Examiner further states that “[i]t would have been obvious to a person of ordinary skill in the art to include in Fortenberry and Hartman the improvements as cited in Rhoads, because utilizing existing infrastructure, along with the convenience of having the access code readily available will provide for increased usage of the system and therefore increased revenue.”¹⁴¹

Dependent Claims 13 and 28 depend from, and further limit, Independent Claim 1. Dependent Claims 18, 26 and 29 depend from, and further limit, Independent Claim 14. These dependent claims are allowable for at least the reasons as the claims from which they depend, as discussed above. Additionally, the asserted combination of *Fortenberry*, *Hartman* and *Rhoads* does not teach all the limitations of the claims as discussed herein below.

a. Discussion of *Rhoads* – TSM Test.

The Examiner has provided Rhoads to cure the deficiency of *Fortenberry* and *Hartman*. The primary purpose of *Rhoads* is to provide a system that gives a user the ability to use an optical input to interface with computers; thus, enabling everyday objects to communicate their identities and functions.¹⁴² The *Rhoads* system incorporates an optical sensor, such as a digital camera, a computer, and a network connection.¹⁴³ The problems sought to be solved by *Rhoads* relate to the control of a computer through the use of paper objects instead of other peripheral devices, such as a mouse or keyboard.¹⁴⁴ Objects preferably are steganographically encoded with information that is often imperceptible to the human eye.¹⁴⁵ An optical scanner is capable of detecting the steganographically encoded data. Once detected, a computer acknowledges the

¹⁴⁰ See Final Office Action mailed April 05, 2007, page 6.

¹⁴¹ See Final Office Action mailed April 05, 2007, page 6.

¹⁴² See *Rhoads* Col. 2, lines 19-27.

¹⁴³ See *Rhoads* Col. 2, lines 64-67; Figure 1.

¹⁴⁴ See *Rhoads*, Col. 36, lines 1-6.

¹⁴⁵ See *Rhoads*, Col 3, lines 1-29.

detection by emitting a “Bedoop” sound.¹⁴⁶ The encoded data is divided into three fields: Class, DNS and UID. The Class and DNS identify the server and computer that will respond to the data while the UID determines what the response will be.¹⁴⁷ A steganographically encoded excel document can be scanned to retrieve that document for editing.¹⁴⁸ Additionally, the optical scanner can scan a driver’s license or other government issued document to access records controlled by the Department of Motor Vehicles or other government records respectively. *Rhoads* is also operable to scan a credit card in order to access bank records.¹⁴⁹

Rhoads provides a way for users to access resources on a computer, whether local or remote, without the need of a peripheral device such as a keyboard or mouse. *Rhoads* is directed towards placing a scan-able code on an object. *Rhoads* scans this code in order to facilitate the control of certain computer functions. *Rhoads* discloses numerous methods and applications wherein a computer process is enhanced. These enhancements, in some cases, effectively result in the elimination of a need to use a mouse or keyboard. In one example, *Rhoads* discloses scanning a credit card. The card is scanned in order to process a payment of selected item on a previously selected vendor site. By manipulating the position of the card, the system processes mailing instructions as well. In a summary of the invention, *Rhoads* discloses the following:

“Bedoop.” That might be the sound that someone might hear as they lazily place a magazine advertisement in front of their desktop camera. Magically, the marketing and sales web site associated with the ad is displayed on their computer. More information? Want to buy now? Look at the full product line? No problem.

“Bedoop.” That might be the same sound when that same someone places their credit card in front of their desktop camera. Instantly, the product displayed on the web page is purchased. Behind the scenes, a secure purchase link is initiated, transmitting all requisite information to the vendor. Twist the credit card clockwise and the purchaser chooses overnight delivery.

So goes an exemplary embodiment of the invention further described in this application. Though this example is rather

¹⁴⁶ See *Rhoads*, Col 3, lines 1-29.

¹⁴⁷ See *Rhoads*, Col 7, lines 8-36.

¹⁴⁸ See *Rhoads*, Col 3, lines 57-67; Col. 4, lines 1-26.

¹⁴⁹ See *Rhoads*, Col 22, 42-45.

specific, it nevertheless alludes to an indescribably vast array of applications possible when a digital camera or other optical sensing device is turned into a general purpose user interface device with an intuitive power that very well might rival the mouse and the keyboard.¹⁵⁰

Clearly, *Rhoads* discloses another mechanism to be used in addition to, or even in replacement of, other computer peripherals, such as a mouse or keyboard. *Rhoads* is disclosing a system to use common items as sources of computer control in the way a user currently utilizes a mouse or keyboard. However, *Rhoads* only discloses that an MRC encoded on an object, such as a credit card, can be used to *access* a site or *manipulate* simple commands on a computer.

Dependent Claim 13 recites that the unique code is on a credit card. The Examiner states that *Rhoads* teaches that the unique code is placed on a credit card at column 1, lines 35-40.¹⁵¹ However, this portion describes the “BEDOOP” code, which is a sound. *Rhoads* uses a digital code that is hidden on an object and placed in front of the camera to extract this information. *Fortenberry* teaches that a user provides a public key to a vendor prior to the user requesting encrypted data be sent to the vendor. The vendor uses the public key to unlock and decrypt the encrypted data. One skilled in the art would recognize that a public key used for decryption is an algorithm. *Fortenberry* describes the function of the security keys as follows:

A security level is also used to assign an encryption key base on a user's password. *The encryption method uses the concept of public and private keys* so that the public key is given to the user to access passport data and the passport agent presents the encrypted user data based on the private key. No one but the passport agent on the Internet has access to the private key. *The passport owner has a copy of the public key.*¹⁵² (*emphasis added*)

If the data is encrypted, *the private key is used to encrypt* the contents of the user environment variables. The encrypted data contains the name of the user environment variable and its assigned value. Otherwise, the requested information is sent to the vendor by passport agent 216, as illustrated by process block 516. When the vendor, i.e. the web server receives passport data from the passport agent 216, and such user information is encrypted, *the*

¹⁵⁰ See *Rhoads*, Col. 1, lines 28-41.

¹⁵¹ See Final Office Action mailed April 05, 2007, page 6.

¹⁵² See *Fortenberry*, Col. 8, lines 16-22.

public key sent by the user is used to unlock and decrypt the passport data, as illustrated by the decisional block 518 and process block 520. If the public security key does not unlock the passport data, the vendor simply ignores the users request.¹⁵³ (emphasis added)

Clearly, *Fortenberry* teaches standard encryption and decryption algorithms as public and private keys as is known in the art. An algorithm is not the type of unique code that can be placed on a credit card. As such, *Fortenberry* and *Hartman* cannot be combined in a manner required by the claims of the instant application.

Additionally, *Hartman* teaches the use of a “cookie” disposed on a server. Appellants stated, regarding the combination of *Hartman* and *Rhoads*: “it could be that the profile information is actually coded thereon. However, this is nothing more than a code that is given to a user. There is no suggestion or motivation for a cookie to be disposed in a card that a user would have. First, in *Hartman*, there is no disclosure that the user has a code; rather, the server actually creates the code, possesses the code, and then stores it on the computer. This is not unique to a user but, rather, it is only unique to a particular client device and, through the relational link with the database, to that user’s purchaser-specific order information. Since the user need not enter the information, there is no reason for the user to have such. As such, *Rhoads* does not appear to be a proper combination for this aspect of the invention.”¹⁵⁴

As such, *Rhoads* does not provide a teaching that cures the conceded deficiencies of the combination of *Fortenberry* and *Hartman*. The Examiner identified a particular element in the prior art, that being the limitation of a steganographically encoded object disposed on a credit card of a user. *Kahn* states that “a mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.”¹⁵⁵ Rather than concentrate on this element, the Examiner is required to articulate the basis on which the Examiner concludes that it would have been obvious to make the claimed invention, i.e., why one of ordinary skill in the art would have been motivated to select the references and to combine them in order to render the claimed invention obvious. The combination of

¹⁵³ See *Fortenberry*, Col. 8, lines 54-64.

¹⁵⁴ See Response dated January 17, 2007, pages 16-17.

¹⁵⁵ *Kahn*, 441 F.3d at 986.

Fortenberry, *Hartman* and *Rhoads* does not teach “a unique code placed on a credit card” as required by the claims of the instant application. The Examiner’s reliance on the asserted combination to support the rejection of Claims 13, 18, 26, 28 and 29 is clear error.

Further, Claims 28 and 29 recite that the populated form is transmitted to the vendor location to complete the on-line transaction. The Examiner has not provided a citation, or directed Appellants to a teaching in any of the references that discloses that the populated form is transmitted to the vendor location. *Fortenberry* teaches that an encrypted file containing passport data is transmitted to the vendor. *Fortenberry* contains no teaching for a form, much less a form transmitted to a vendor to complete an on-line transaction. *Hartman* teaches that the user information is stored in a server system and, when a purchase is made, the server system provides a confirmation page to the user. *Hartman* does not disclose a form transmitted to a vendor to complete an on-line transaction. *Rhoads* teaches an input device to control the functions of a computer. *Rhoads* contains no teaching for a form or a form transmitted to a vendor to complete an on-line transaction. As such, *Fortenberry*, *Hartman* and *Rhoads*, taken singularly or in combination, do not teach that the populated form transmitted to a vendor to complete an on-line transaction.

VIII. Conclusion

In Summary, Appellants contend that all three of the references fail to provide a suggestion, motivation, or teaching for the various combinations because the text fails to illustrate “why” one skilled in the art would combine the references in the particular manner required to provide a predictable variation. Instead, the Examiner simply identifies particular components for each reference, combines them in a specific manner required by Appellants’ claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Appellants respectfully submit that the cited combinations are improper for reasons detailed above and requests that the rejections under § 103 be withdrawn.

Respectfully submitted,

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CLAIMS APPENDIX

Claim 1. A method of processing profile information of a user for conducting an on-line transaction between the user and a vendor, comprising the steps of:

entering profile information of a user into a profile form at a user location disposed on a network prior to conduction of an on-line transaction between the user and the vendor, the vendor disposed at a vendor location on the network;

issuing to the user a unique code representing stored profile information of the user in response to the user transmitting the profile form from the user location to a second location on the network for storage thereat, the second location disposed on the network;

initiating an on-line transaction by selecting a product of the vendor at a user location;

after selecting the product, providing to the vendor location by the user the unique code for purchase of the product, during the on-line transaction, which on-line transaction requires the user to view a vendor payment form at the user location representing information about the transaction, and which vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user and which must be viewed by the user prior to completion of the on-line transaction;

providing the stored profile information from the second location to the vendor location in response to the vendor location receiving and processing the unique code; and

automatically inserting by the vendor at least a portion of the stored profile information of the user into the vendor payment form for respective associated fields therein for presentation to the user at the user location after such insertion such that, when the user receives the form for viewing, such insertion has already occurred, such that the user has not viewed the form other than with already populated certain fields prior to reception.

Claim 2. The method of Claim 1, wherein the user fills in the profile form only one time.

Claim 3. The method of Claim 1, wherein the profile form is transmitted to the second location over a public switched telephone network.

Claim 4. The method of Claim 1, wherein the vendor location receives the profile information from the second location in response to the vendor location transmitting the unique code to the second location.

Claim 5. The method of Claim 1, wherein the unique code is unique and has a unique ID number associated therewith.

Claim 6. The method of Claim 1, wherein the unique code has a unique ID number associated therewith and the user provides the unique ID number to the vendor location for payment purposes.

Claim 7. The method of Claim 1, wherein the step of automatically inserting causes all of the profile information to be entered into the vendor payment form as encoded information.

Claim 8. The method of Claim 1, wherein the step of automatically inserting causes only a portion of the profile information to be entered into the vendor payment form as encoded information.

Claim 9. The method of Claim 8, wherein the portion of the profile information is credit information.

Claim 10. The method of Claim 1, wherein the profile information comprises name, address, ship-to address, and credit information.

Claim 11. The method of Claim 5, wherein the second location is a central registration server having a database of the profile information associated with respective unique codes and unique ID numbers.

Claim 12. The method of Claim 11, wherein the second location is a credit card company server.

Claim 13. The method of Claim 1, wherein the unique code is placed on a credit card.

Claim 14. A system for processing profile information of a user for conducting an on-line transaction between the user and a vendor, comprising;

profile information of a user entered into a profile form at a user location disposed on a network prior to conduction of an on-line transaction between the user and the vendor, the vendor disposed at a vendor location on the network;

a unique code representing stored profile information of the user issued to the user in response to said user transmitting said profile form from said user location to a second location on the network for storage thereat, said second location disposed on said network;

wherein said unique code is provided to the vendor location by the user for purchase of a product of the vendor after the user has viewed and made a selection of the product, during the on-line transaction, which on-line transaction requires the user to view a vendor payment form at the user location representing information about the transaction, and which vendor payment form includes fields that are associated with information obtainable from the stored profile information of the user and which must be viewed by the user prior to completion of the on-line transaction;

wherein said profile information is provided from said second location to said vendor location in response to said vendor location processing said unique code; and

wherein at least a portion of said stored profile information of the user is automatically inserted into said vendor payment form by the vendor for respective associated fields therein for presentation to said user at the user location after such insertion such that, when the user receives the form for viewing, such insertion has already occurred, such that the user has not viewed the form other than with already populated certain fields prior to reception.

Claim 15. The system of Claim 14, wherein said user fills in said profile form only one time.

Claim 16. The system of Claim 14, wherein said profile form is transmitted to said second location over a public switched telephone network.

Claim 17. The system of Claim 16, wherein said vendor location receives said profile information from said second location in response to said vendor location transmitting said unique code to said second location.

Claim 18. The system of Claim 14, wherein said unique code comprises a bar code.

Claim 19. The system of Claim 14, wherein said unique code has a unique ID number associated therewith and said user provides said unique ID number to said vendor location for payment purposes.

Claim 20. The system of Claim 14, wherein all of said profile information is automatically inserted into said vendor payment form as encoded information.

Claim 21. The system of Claim 14, wherein only a portion of said profile information is entered into said vendor payment form as encoded information.

Claim 22. The system of Claim 21, wherein said portion of said profile information is credit information.

Claim 23. The system of Claim 14, wherein said profile information comprises the user's name, address, ship-to address and credit information.

Claim 24. The system of Claim 19, wherein said second location is a central registration server having a database of said profile information associated with respective said unique code and said unique ID number.

Claim 25. The system of Claim 24, wherein said second location is a credit card company server.

Claim 26. The system of Claim 14, wherein said unique code is placed on a credit card.

Claim 27. The system Claim 19, wherein said second location is a central registration server having a database of said profile information associated with respective said unique code and said ID number.

Claim 28. The method of Claim 1, and further comprising transmitting the populated form to the vendor location to complete the on-line transaction.

Claim 29. The system of Claim 14, wherein the populated form is transmitted to the vendor location to complete the on-line transaction.

EVIDENCE APPENDIX

A. U.S. Patent No. 6,005,939 to Fortenberry ("*Fortenberry*") found on pages 3-6 of the Final Office Action (mailed April 05, 2007).

B. U.S. Patent No. 5,960,411 to Hartman ("*Hartman*") found on pages 3 and 4 of the Final Office Action (mailed October 31, 2005); found on pages 3 and 4 of the Office Action (mailed July 18, 2006); and found on pages 3-6 of the Final Office Action (mailed April 05, 2007).

C. U.S. Patent No. 6,311,214 to Rhoads ("*Rhoads*") found on pages 3 and 4 of the Final Office Action (mailed October 31, 2005); found on pages 3 and 4 of the Office Action (mailed July 18, 2006); and found on pages 5-6 of the Final Office Action (mailed April 05, 2007).

D. U.S. Patent No. 6,297,819 to Furst ("*Furst*") found on pages 3-11 of the Office Action (mailed March 11, 2005).

E. U.S. Patent No. 6,192,380 to Light et al. ("*Light*") found on pages 2-7 of the Office Action (mailed May 06, 2003); found on pages 2, 3 and 5 of the Final Office Action (mailed December 30, 2003); found on pages 2, 4, 9 and 10 of the Office Action (mailed June 15, 2004); and found on page found on pages 3 and 6 of the Office Action (dated March 11, 2005).

F. U.S. Patent No. 6,192,380 to Reber et al. ("*Reber*") found on pages 3-9 of the Office Action (mailed March 19, 2002); found on pages 2-12 of the Final Office Action (mailed December 11, 2002); found on pages 2-11 of the Office Action (mailed May 06, 2003); found on pages 2-11 of the Final Office Action (mailed December 30, 2003); found on pages 2-10 of the Office Action (mailed June 15, 2004); and found on page found on pages 3, 4 and 6 of the Office Action (dated March 11, 2005).

G. U.S. Patent No. 5,956,699 to Wong et al. ("*Wong*") found on pages 5-6 of the Office Action (mailed March 19, 2002); found on pages 4-5 and 12 of the Final Office Action (mailed December 11, 2002); found on pages 3 and 8 of the Office Action (mailed May 06,

2003); found on pages 7-8 of the Final Office Action (mailed December 30, 2003); and found on pages 6-7 of the Office Action (mailed June 15, 2004).

H. U.S. Patent No. 6,192,380 to Gardenswartz et al. (“*Gardenswartz*”) found on pages 7-8 of the Office Action (mailed March 19, 2002); found on pages 6-7 and 13 of the Final Office Action (mailed December 11, 2002); found on pages 4 and 10-11 of the Office Action (mailed May 06, 2003); found on pages 9-10 of the Final Office Action (mailed December 30, 2003); and found on pages 8-9 of the Office Action (mailed June 15, 2004).

I. U.S. Patent No. 6,192,380 to Green et al. (“*Green*”) found on pages 6 and 13 of the Final Office Action (mailed December 11, 2002); found on pages 9 and 10 of the Office Action (mailed May 06, 2003); found on pages 8 and 9 of the Final Office Action (mailed December 30, 2003); and found on pages 7 and 8 of the Office Action (mailed June 15, 2004).

J. Non-Entered Amendment After Final dated April 05, 2007.